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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,423	01/21/2004	Shigeo Fujii	T3201.0041	1238
32172	7590	06/30/2009		
DICKSTEIN SHAPIRO LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) NEW YORK, NY 10036-2714			EXAMINER SMITH, CREIGHTON H	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 06/30/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/760,423

Applicant(s)

FUJII, SHIGEO

Examiner

CREIGHTON SMITH

Art Unit

2614

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 MAR '09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-73 is/are allowed.
- 6) ☒ Claim(s) 1 and 74-76 is/are rejected.
- 7) ☒ Claim(s) 2-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Appeal

Prosecution on the merits is re-opened because claims 74-76 contain non-statutory 35 U.S.C. 101 subject matter.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. The claims are directed to transient matter, i.e., a signal which is not patentable.

For non-transient invention, the MPEP §2106(IV) A. states that the four categories of subject matter that Congress deemed to be appropriate of a patent under 35 U.S.C 101 are processes, machines, manufactures, and composition of matter. Applicant's claims 74-76 recite "a program as an electrical signal," which is NOT one of the four enumerated categories of statutory inventions contemplated by Congress, and therefore not patentable. It's a program, per se, claiming an electrical signal. Neither a "program" per se, nor an "electrical signal" per se, fall within any of the four enumerated statutory categories.

Applicant has disclosure on page 18 of the spec that the controller/PBX (1) has a recording medium (16) which is a memory "for storing a program (a program executable on a computer) for controlling the PBX." Therefore, applicant should delete the language "as an electrical signal" in the independent claims and amend it to read "A recording medium storing a program for causing a PBX/call controller . . ."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(E) as being anticipated by Fuoss et al, U.S. Pat. #6,970,696.

Fuoss et al disclose an Internet telephone system/network 100, col. 3, line 4. They also disclose IP telephones 120, col. 3, lines 19-20, as network communication devices, col. 3, lines 16-17 & 20 -25. Network communication devices 120 may include desktop PCs (laptops), col. 3, lines 20-25, and which may be equipped with the appropriate hardware and software to receive, process, and transmit IP (Internet Protocol) voice data through network 100. In col. 3, lines 29 et seq. Fuoss et al disclose a docking station 140 that is coupled to the network devices 120. With Newton's Telecom Dictionary definition of docking station being a base station for laptop, Fuoss et al meet applicant's limitation in claim 1 of an information processor (the laptop included with a docking station, according to Newton's Dictionary) having an Internet telephone function able to make a call to a counterpart terminal (the plurality of network communication devices (120). So, a laptop associated with docking station 140 is able

to make an Internet phone call to other network communication devices 120 or to other docking stations 130, because Fuoss et al disclose in col. 3 that network 100 could include the Internet and network communication devices 120 can receive, process and transmit IP voice data. Therefore, Fuoss et al Information processor (docking station 140 with associated laptop) can make an Internet phone call to counterpart terminal 120 or 130.

Fuoss et al also disclose a network control device 170, col. 3, line 9, that may include a network call controller, line 10, such as a PBX switch, line 13. As shown in Fig. 1, PBX 170 connects to information processor 140 via a solid black line, which could be an Internet connection as disclosed by Fuoss et al in line 4 of col. 3. Fuoss et al call controller/PBX 170 accommodates a telephone terminal 110, because wireless phone 110 couples to docking station 140, col. 4, lines 4-6. Fuoss et al disclose, col. 4, lines 13 et seq. that after device 110 is placed in the docking station's housing 141, the docking station can communicate through Internet network 100 through device 110 which is connected to network 100 over wireless network 160. So, if network 100 is the Internet as Fuoss et al have disclosed in col. 3, line 4, then terminal 110 is used as an Internet handset because it is communicating with network 100 (the Internet).

Allowable Subject Matter

Claims 26-73 are allowed.

Claims 2-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication should be directed to CREIGHTON SMITH at telephone number (571)272-7546.

22 JUN '09

/CREIGHTON SMITH/
Primary Examiner, Art Unit 2614

/NICK CORSARO/

Supervisory Patent Examiner, Art Unit 2617